

Amendment and Response Under 37 C.F.R. 1.116

Applicant: Jerome D. Brown et al.

Serial No.: 10/672,166

Filed: September 26, 2003

Docket No.: 10387US01 (I201.180.101)

Title: TAPE REEL ASSEMBLY WITH RADIALLY SYMMETRIC DEFORMING TAPE WINDING SURFACE

REMARKS

The following remarks are made in response to the Final Office Action mailed August 26, 2005 and to the Advisory Action mailed November 4, 2005.

In the Final Office Action, claims 1-20 were rejected under 35 U.S.C. § 112, second paragraph. In addition, claims 1, 2, 5-9, 12-16, 19, and 20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Zwettler et al., U.S. Patent No. 6,474,582 (“Zwettler”), claims 3, 4, and 18 were rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious, over Zwettler, and claims 10, 11, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zwettler in view of Hiraguchi et al., U.S. Patent No. 6,736,345 (“Hiraguchi”).

In the Advisory Action, amendments to claims 1, 12, 18, and 20 were entered to remove rejections to the claims under 35 U.S.C. § 112, second paragraph, which is noted with appreciation. The Final Office Action rejections to the claims under 35 U.S.C. §§ 102(a) and 103(a) were maintained.

With this Response, claims 8-9 and 15 have been cancelled, and claims 1, 10-12, and 16-18 have been amended to place the application in condition for allowance. Claims 1-7, 10-14, and 16-20 remain pending in the application and are presented for consideration and allowance.

Claim Rejections under 35 U.S.C. § 112

Claims 1, 12, 18, and 20 were amended in an Amendment and Response under 37 C.F.R. § 1.116 dated October 24, 2005. The Advisory Action mailed November 4, 2005 noted that the amendments to the claims had been entered, which is noted with appreciation. Thus, it is believed that the rejections to claims 1-20 under 35 U.S.C. § 112, second paragraph, have been traversed.

Claim Rejections under 35 U.S.C. §§ 102 and 103

In the Final Office Action mailed August 25, 2004, claims 1, 2, 5-9, 12-16, 19, and 20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Zwettler; claims 3, 4, and 18

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were rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious, over Zwettler; and claims 10, 11, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zwettler in view of Hiraguchi.

The Advisory Action mailed November 4, 2005 maintained the rejections set forth in the Final Office Action.

A telephone conference with the Examiner was conducted on November 28, 2005. In the telephone conference, Applicant's representative respectfully suggested a course of action that would present the pending claims in condition for allowance with a submission of an Amendment and Response after Final. The Examiner's guidance in this matter is noted with appreciation. The Examiner tentatively approved of the suggested course of action that includes the Applicants submitting an affidavit under § 1.131 to swear behind Zwettler and remove rejections under 35 U.S.C. § 102(a), amending the claims to remove possible future rejections over Zwettler under 35 U.S.C. § 102(e), and concurrently submitting a statement of common ownership under 37 C.F.R. § 1.130 to overcome rejections and possible future rejections under 35 U.S.C. § 103.

With this Response, the Applicants submit an affidavit under § 1.131 to swear behind Zwettler and remove rejections under 35 U.S.C. § 102(a).

Zwettler was filed on March 26, 2001. Zwettler published on September 6, 2002. The pending application was filed on September 26, 2003. Thus, Zwettler does not qualify as a 35 U.S.C. § 102(b) reference. Claims 1, 2, 5-9, 12-16, 19, and 20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Zwettler; claims 3, 4, and 18 were rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious, over Zwettler.

With this response, a declaration of under 37 C.F.R. § 1.131 is submitted to establish invention of the subject matter of the rejected claims prior to the Zwettler publication date of September 6, 2002. In particular, a Confidential Imation Internal Correspondence document dated May 31, 2002, identified herein as Exhibit A, is submitted as evidence of invention of the subject matter of the rejected claims prior to the Zwettler publication date of September 6, 2002. Exhibit A describes a pack stress analysis of a 9940 three piece hub design. Reference is made

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to Figure 2 of Exhibit A that illustrates a cross-sectional view of a hub design related to the subject matter of the rejected claims.

It is respectfully submitted that the subject matter of the pending application was invented prior to the Zwettler publication date of September 6, 2002, and that this prior conception was coupled with due diligence from prior to September 6, 2002 to the filing date of the pending application on September 26, 2003. Based upon this, it is respectfully requested that the rejections to pending claims under 35 U.S.C. § 102(a) over Zwettler be withdrawn.

With this response, claims 1, 10-12, and 16-18 have been amended to define over Zwettler and obviate possible future rejections under 35 U.S.C. § 102(e) over Zwettler.

Zwettler teaches in column 2, lines 55-61 a tape cartridge 10 including a housing 12 and a tape reel assembly 14. Zwettler teaches at column 3, lines 46-53 that the tape reel assembly 14 has three major components: a top flange 40, a bottom flange 50 and a hub 60. Zwettler teaches at column 5, lines 5-15 that securing the flanges 40, 50 to the hub 60 with notches 41a – 41c and post 68 allow for the hub 60 to be compressed independently without experiencing restriction from the flanges 40, 50 as storage tape 16 is wound around the hub 60. Zwettler teaches at column 5, lines 10-13 that enlarged area 67a and the enlarged area of post 68 prevent the flanges from moving apart from each other, but does not prevent the hub from deforming inwardly as tape is wound around the hub.

Amended independent claim 1 provides a tape reel assembly including a hub comprising an upper flange and a lower flange, wherein the upper and lower flanges exhibit symmetrical deformation upon application of a radial load to the tape winding surface. In contrast, the stiffer flanges taught in Zwettler (column 4, lines 64-66) are prevented from moving apart during an application of a load. Thus, it is respectfully submitted that Zwettler does not teach or suggest upper and lower flanges that exhibit symmetrical deformation upon application of a radial load to a tape winding surface, as required by amended independent claim 1.

Amended independent claim 12 provides a data storage tape cartridge including a housing defining an enclosed region, and at least one tape reel assembly rotatably disposed within the enclosed region and including a hub comprising an upper flange and a lower flange, and at least one of the upper flange and the lower flange is laser welded to the hub. In contrast,

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Zwettler teaches two stiff metallic flanges provided as components of a tape reel assembly that are pinned via post 68 to the hub 60. Thus, it is respectfully submitted that Zwettler does not teach or suggest at least one of the upper and lower flanges being laser welded to the hub, as required by amended independent claim 12.

Amended independent claim 18 provides a method of winding data storage tape onto a tape reel assembly comprising providing a data storage tape cartridge having a housing enclosing the tape reel assembly, wherein the tape reel assembly includes a hub comprising an upper flange and a lower flange and an annular arm defining a tape winding surface, wherein the tape winding surface and the upper and lower flanges exhibit approximately symmetrical radial deformation in response to an applied stress. It is respectfully submitted that Zwettler does not teach or suggest a tape reel assembly providing a tape winding surface and upper and lower flanges that exhibit approximately symmetrical radial deformation in response to an applied stress, as required by amended independent claim 18.

It is respectfully submitted that independent claims 1, 12, and 18 cannot be anticipated by Zwettler. Dependent claims 2-7, and 10-11 depend from amended independent claim 1; dependent claims 13-14, and 16-17 depend from amended independent claim 12; and dependent claims 19 and 20 depend from amended independent claim 1, such that all of the claims define over Zwettler and obviate possible future rejections under 35 U.S.C. § 102(e) over Zwettler.

With this response, a declaration is submitted to disqualify Zwettler as prior art since Zwettler is a commonly owned patent. In particular, a terminal disclaimer is submitted in accordance with 37 C.F.R. § 1.321(c), and a declaration is submitted stating that Zwettler is currently owned by the same assignee, and that Jerome D. Brown named in the pending application is a prior inventor under 35 U.S.C. § 104 and is identical to Jerry D. Brown, a named inventor in the Zwettler patent. With this in mind, it is respectfully requested that rejections to the pending claims under 35 U.S.C. § 103(a) over Zwettler be withdrawn.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-7, 10-14, and 16-20 recite patentable subject matter, and are in form for allowance. Therefore, reconsideration

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and withdrawal of the rejections, and allowance of claims 1-7, 10-14, and 16-20 is respectfully requested.

A fee of \$450 is required under 37 C.F.R. 1.17(a)(1) for an extension of the Response within the second month and a fee for \$130 is required under 37 C.F.R. 1.20(d) for a Terminal Disclaimer. The Patent Office is hereby authorized to charge Deposit Account No. 09-0069 in the amount of \$450 and \$130 for these fees.

The Examiner is invited to telephone the Applicant's representative to facilitate prosecution of this application. Inquiries regarding this Response should be directed to Eric D. Levinson at Telephone No. (651) 704-3604, Facsimile No. (612) 704-5951.

Respectfully submitted,

Date: 1/25/06


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